

REMARKS

Reconsideration and further examination of this application is hereby requested. Claims 1-32 are currently pending in the application. Claims 1, 30, 31, and 32 have been amended to delete instances of the term "direct".

Claims 1-9, 11-28, and 30-32 have been rejected under 35 U.S.C. § 103(a) as being obvious over Nilsen (patent US 5987306) in view of Buchbinder (patent publication US 2002-0078198).

Claim 10 has been rejected under 35 U.S.C. § 103(a) as being obvious over Nilsen in view of Buchbinder and further in view of Martin (patent US 6363419). Claim 29 has been rejected under 35 U.S.C. § 103(a) as being obvious over Nilsen in view of Buchbinder and further in view of Reeves (patent US 5918023). These rejections are respectfully traversed based on the following arguments.

There are two independent reasons why the claimed invention would not have been obvious. First, the prior art does not provide evidence that the implementation of two modems would have been obvious. Second, the Buchbinder reference does not constitute prior art with regard to Wireless Access Protocol teachings. These reasons are explained in detail below.

A. No Evidence Implementing Two Modems Would Have Been Obvious

In order for a patent claim to be obvious, the prior art must teach or fairly suggest each and every limitation recited in

the claim. That is because the claim must be considered as a whole.

The Patent Examiner acknowledges that the claims recite both a "test traffic modem" and a "control link modem" and contends that the Nilsen prior art reference discloses structures that correspond to both. However, study of Nilsen reveals that only one modem is taught as being used in its mobile unit structure. As the mobile unit is described in the Nilsen APPENDIX, only one modem is mentioned. See col. 20, line 9. As the mobile unit is described in claim 9 of Nilsen, only one modem is mentioned. See col. 21 at line 28. The Buchbinder reference does not disclose both the "test traffic modem" and "control link modem" structures and, in any case, the Examiner does not allege that it does.

Perhaps sensing that the Nilsen and Buchbinder teachings taken together do not disclose both a "test traffic modem" and a "control link modem", the Examiner reasons:

that it would have been obvious to one of ordinary skill in the art to perform the modification of internalizing said modem within the architecture of said MTU, as it was well known to reduce the number of components in a system by having one component performing multiple functions.

See Office Action of Dec. 12, 2006 at page 3, line 21 through page 4, line 2.

One flaw of this reasoning is that it assumes, without benefit of evidence or logical reasoning, the prior art possessed the idea of multiple modems or multiple modem functions. The

Examiner has identified no evidence of this, and has not provided a reasoned case as to why a person having ordinary skill in the art would have wanted to have two modems or two modem functionalities. Noting that "it was well known to reduce the number of components in a system by having one component performing multiple functions" is not sufficient to supply an explanation as to why persons having ordinary skill in the art would have wanted multiple modem functions in such a device.

A second flaw of this reasoning is that it turns the obviousness inquiry on its head. By urging the modification of "to reduce the number of components in a system by having one component performing multiple functions" the Examiner is actually considering modification of the claimed invention to read on the prior art rather than modification of prior art to read on the claimed invention. This is a subversion of the appropriate obviousness analysis wherein the differences between the prior art and the claimed invention are ascertained and a determination is made whether it would have been obvious to modify the prior art to bridge those differences. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, __, 148 U.S.P.Q. 459, 467 (1966); *In re Kahn*, 441 F.3d 977, 986, 78 U.S.P.Q.2d 1329, 1335 (Fed. Cir. 2006). In order to make out a *prima facie* case of obviousness the Examiner would need to have constructed a reasoned case as to why a person having ordinary skill in the art would have modified

the mobile units of the prior art to have both a test traffic modem and a control link modem. That has not been done thus far in the prosecution of this application.

For the above reasons, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1-32.

B. Buchbinder Not Prior Art Regarding WAP Teachings

Applicant notes that the Buchbinder reference (patent application publication no. US 2002-0078198) is not prior art for the purpose it is being used for by the PTO. That is because Wireless Access Protocol (or WAP) portions of the disclosure were not present in the earlier application (appln. no. 09/513,550, filed Feb. 25, 2000) from which Buchbinder claims priority; the WAP portions were added later when the Buchbinder application was filed Feb. 15, 2002. Thus, Buchbinder is not valid evidence against the claims in the instant application.

Since the Buchbinder reference is an essential evidentiary element of all of the prior art rejections, and is not prior art with respect to the claimed WAP feature of the invention, Applicant further respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1-32.

C. Closing

For the above reasons, Applicant respectfully submits that the application is in condition for allowance with claims 1-32. If there remain any issues that may be disposed of via a telephonic interview, the Examiner is kindly invited to contact the undersigned at the telephone number given below.

The Director of the U.S. Patent & Trademark Office is authorized to charge any necessary fees, and conversely, deposit any credit balance, to Deposit Account No. 18-1579.

Respectfully submitted,
ROBERTS MARDULA & WERTHEIM, LLC

/Kevin L. Pontius/

Kevin L. Pontius, Reg. No. 37512
(703) 391-2900

Roberts Mardula & Wertheim, LLC
11800 Sunrise Valley Dr.
Suite 1000
Reston, VA 20191